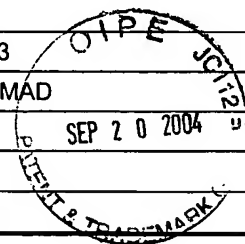


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| <b>TRANSMITTAL FORM</b><br><i>(to be used for all correspondence after initial filing)</i> | Application Number   | 10/718,779             |                 |
|  | Filing Date          | November 20, 2003      |                 |
|  | First Named Inventor | CHISHTI, MUHAMMAD      |                 |
|  | Art Unit             | 3732                   |                 |
|  | Examiner Name        | Wilson, John           |                 |
| Total Number of Pages in This Submission   | 13                   | Attorney Docket Number | 018563-004820US |



| ENCLOSURES (Check all that apply)   |   |  |
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| <input type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input checked="" type="checkbox"/> Supplemental Information Disclosure Statement<br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Response to Missing Parts/Incomplete Application<br><input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input checked="" type="checkbox"/> CD, Number of CD(s) (Reference Copies) <u>1</u> | <input type="checkbox"/> After Allowance Communication to Technology Center (TC)<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):<br>Return Postcard<br>Fee Authorization (See IDS page 2) |
| Remarks: The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.   |   |  |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT |   |
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| Firm or Individual name                    | Townsend and Townsend and Crew LLP<br>James M. Heslin Reg. No. 29,541 |
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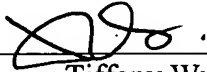
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

On

9/16/04

TOWNSEND and TOWNSEND and CREW LLP

By:



Tiffany Wu

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**



In re application of:

MUHAMMAD CHISHTI et al.

Application No.: 10/718,779

Filed: November 20, 2003

For: COMPUTER AUTOMATED  
DEVELOPMENT OF AN  
ORTHODONTIC TREATMENT PLAN  
AND APPLIANCE

Examiner: Wilson, John

Art Unit: 3732

SUPPLEMENTAL INFORMATION  
DISCLOSURE STATEMENT UNDER 37  
CFR §1.97 and §1.98

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The references cited on attached form PTO/SB/08A and PTO/SB/08B are being called to the attention of the Examiner. Copies of the references are enclosed on 1 CD-ROM.

It is respectfully requested that the cited references be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

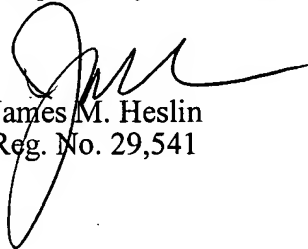
The references cited in the accompanying PTO/SB/08A and PTO/SB/08B, were identified by either or both parties in litigation between Align Technology, Inc., assignee of the above-referenced patent application, andOrmco Corporation in case no. SACV 03-16-GLT (ANX) before the U.S. District Court, Central District of California, Southern Division, as being

potentially relevant to the design, fabrication, and/or use of removable orthodontic appliances and/or to the use of computers or other automatic means for calculating final or intermediate tooth positions for orthodontic treatment.

As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

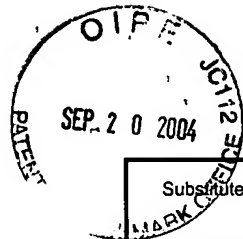
Applicant believes that no fee is required for submission of this statement. However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,



James M. Heslin  
Reg. No. 29,541

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Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
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60301696 v1



Substitute for form 1449A/PTO

# INFORMATION DISCLOSURE STATEMENT BY APPLICANT

*(use as many sheets as necessary)*

Sheet **1** of **10**

## Complete if Known

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|------------------------|-------------------|
| Application Number     | 10/718,779        |
| Filing Date            | November 20, 2003 |
| First Named Inventor   | CHISHTI, MUHAMMAD |
| Art Unit               | 3732              |
| Examiner Name          | Wilson, John      |
| Attorney Docket Number | 018563-004820US   |

## U.S. PATENT DOCUMENTS+

| Examiner<br>Initials* | Cite<br>No. <sup>1</sup> | Document Number                          | Publication Date<br>MM-DD-YYYY | Name of Patentee or<br>Applicant of Cited Document | Pages, Columns, Lines, Where<br>Relevant Passages or Relevant<br>Figures Appear |
|-----------------------|--------------------------|--|--------------------------------|--|---|
|                       |                          | Number Kind Code <sup>2</sup> (if known) |                                |  |   |
|                       | AA                       | 2,467,432                                | 04-19-1949                     | Kesling  |   |
|                       | AB                       | 3,660,900                                | 05-09-1972                     | Andrews  |   |
|                       | AC                       | 3,860,803                                | 01-14-1975                     | Levine   |   |
|                       | AD                       | 3,916,526                                | 11-04-1975                     | Schudy   |   |
|                       | AE                       | 3,950,851                                | 04-20-1976                     | Bergersen  |   |
|                       | AF                       | 4,014,096                                | 03-29-1977                     | Dellinger  |   |
|                       | AG                       | 4,195,046                                | 03-25-1980                     | Kesling  |   |
|                       | AH                       | 4,324,546                                | 04-13-1982                     | Heitlinger et al.                                  |   |
|                       | AI                       | 4,348,178                                | 09-07-1982                     | Kurz   |   |
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|                       | AP                       | 4,663,720                                | 05-05-1987                     | Duret et al.                                       |   |
|                       | AQ                       | 4,742,464                                | 05-03-1988                     | Duret et al.                                       |   |
|                       | AR                       | 4,755,139                                | 07-05-1988                     | Abbatte et al.                                     |   |
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|                       | AU                       | 4,798,534                                | 01-17-1989                     | Breads   |   |
|                       | AV                       | 4,837,732                                | 06-06-1989                     | Brandestini et al.                                 |   |
|                       | AW                       | 4,850,864                                | 07-25-1989                     | Diamond  |   |
|                       | AX                       | 4,856,991                                | 08-15-1989                     | Breads et al.                                      |   |
|                       | AY                       | 4,936,862                                | 06-26-1990                     | Walker et al.                                      |   |
|                       | AZ                       | 4,937,928                                | 07-03-1990                     | van der Zel  |   |
|                       | BA                       | 4,964,770                                | 10-23-1990                     | Steinbichler et al.                                |   |
|                       | BB                       | 4,975,052                                | 12-04-1990                     | Spencer et al.                                     |   |
|                       | BC                       | 5,011,405                                | 04-30-1991                     | Lemchen  |   |
|                       | BD                       | 5,017,133                                | 05-21-1991                     | Miura  |   |
|                       | BE                       | 5,027,281                                | 06-25-1991                     | Rekow et al.                                       |   |
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|                       | BG                       | 5,055,039                                | 10-08-1991                     | Abbatte et al.                                     |   |
|                       | BH                       | 5,059,118                                | 10-22-1991                     | Breads et al.                                      |   |
|                       | BI                       | 5,100,316                                | 03-31-1992                     | Wildman  |   |
|                       | BJ                       | 5,121,333                                | 06-09-1992                     | Riley et al.                                       |   |
|                       | BK                       | 5,128,870                                | 07-07-1992                     | Erdman et al.                                      |   |
|                       | BL                       | 5,131,843                                | 07-21-1992                     | Hilgers et al.                                     |   |
|                       | BM                       | 5,131,844                                | 07-21-1992                     | Marinaccio et al.                                  |   |
|                       | BN                       | 5,139,419                                | 08-18-1992                     | Andreiko et al.                                    |   |
|                       | BO                       | 5,184,306                                | 02-02-1993                     | Erdman et al.                                      |   |

Examiner  
Signature

Date  
Considered

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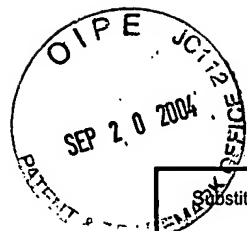
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| <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b><br>(use as many sheets as necessary) |                        |               | Substitute for form 1449A/PTO |                   |
|   |                        |               | Complete if Known             |                   |
|   |                        |               | Application Number            | 10/718,779        |
|   |                        |               | Filing Date                   | November 20, 2003 |
|   |                        |               | First Named Inventor          | CHISHTI, MUHAMMAD |
| Art Unit  | 3732                   | Examiner Name | Wilson, John                  |                   |
| Sheet 2 of 10   | Attorney Docket Number |               | 018563-004820US               |                   |

| U.S. PATENT DOCUMENTS+ |                       |  |                                |  |   |
|------------------------|-----------------------|--|--------------------------------|--|---|
| Examiner Initials*     | Cite No. <sup>1</sup> | Document Number                          | Publication Date<br>MM-DD-YYYY | Name of Patentee or<br>Applicant of Cited Document | Pages, Columns, Lines, Where<br>Relevant Passages or Relevant<br>Figures Appear |
|                        |                       | Number Kind Code <sup>2</sup> (if known) |                                |  |   |
|                        | BP                    | 5,186,623                                | 02-16-1993                     | Breads et al.                                      |   |
|                        | BQ                    | 5,257,203                                | 10-26-1993                     | Riley et al.                                       |   |
|                        | BR                    | 5,273,429                                | 12-28-1993                     | Rekow et al.                                       |   |
|                        | BS                    | 5,278,756                                | 01-11-1994                     | Lemchen et al.                                     |   |
|                        | BT                    | 5,338,198                                | 08-16-1994                     | Wu et al.  |   |
|                        | BU                    | 5,340,309                                | 08-23-1994                     | Robertson  |   |
|                        | BV                    | 5,342,202                                | 08-23-1994                     | Deshayes   |   |
|                        | BW                    | 5,368,478                                | 11-29-1994                     | Andreiko et al.                                    |   |
|                        | BX                    | 5,382,164                                | 01-17-1995                     | Stern  |   |
|                        | BY                    | 5,395,238                                | 03-07-1995                     | Andreiko et al.                                    |   |
|                        | BZ                    | 5,431,562                                | 11-11-1995                     | Andreiko et al.                                    |   |
|                        | CA                    | 5,440,496                                | 08-08-1995                     | Andersson et al.                                   |   |
|                        | CB                    | 5,447,432                                | 09-05-1995                     | Andersson et al.                                   |   |
|                        | CC                    | 5,452,219                                | 09-19-1995                     | Dehoff et al.                                      |   |
|                        | CD                    | 5,454,717                                | 10-03-1995                     | Andreiko et al.                                    |   |
|                        | CE                    | 5,456,600                                | 10-10-1995                     | Andreiko et al.                                    |   |
|                        | CF                    | 5,474,448                                | 12-12-1995                     | Andreiko et al.                                    |   |
|                        | CG                    | 5,518,397                                | 05-21-1996                     | Andreiko et al.                                    |   |
|                        | CH                    | 5,533,895                                | 07-09-1996                     | Andreiko et al.                                    |   |
|                        | CI                    | 5,542,842                                | 08-06-1996                     | Andreiko et al.                                    |   |
|                        | CJ                    | 5,549,476                                | 08-27-1996                     | Stern  |   |
|                        | CK                    | 5,587,912                                | 12-24-1996                     | Andersson et al.                                   |   |
|                        | CL                    | 5,605,459                                | 02-25-1997                     | Kuroda et al.                                      |   |
|                        | CM                    | 5,607,305                                | 03-04-1997                     | Andersson et al.                                   |   |
|                        | CN                    | 5,645,421                                | 07-08-1997                     | Slotsky  |   |
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|                        | CP                    | 5,683,243                                | 11-04-1997                     | Andreiko et al.                                    |   |
|                        | CQ                    | 5,733,126                                | 03-31-1998                     | Andersson et al.                                   |   |
|                        | CR                    | 5,740,267                                | 04-14-1998                     | Echerer et al.                                     |   |
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|--------------------------|-----------------------|---------------------------|---------------------|-----------------------------------|-----------------------------|---|---|--------------------------|
| Examiner Initials*       | Cite No. <sup>1</sup> | Foreign Patent Document   |                     |                                   | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | T <sup>6</sup>           |
|                          |                       | Country Code <sup>3</sup> | Number <sup>4</sup> | Kind Code <sup>5</sup> (If known) |                             |   |   |                          |
|                          | CT                    | EP                        | 091,876             | A1                                | 10-19-1983                  | Duret   |   | <input type="checkbox"/> |
|                          | CU                    | EP                        | 299,490             | A2                                | 01-18-1989                  | Steinbichler et al.                             |   | <input type="checkbox"/> |
|                          | CV                    | EP                        | 376,873             | A2                                | 07-04-1990                  | Shafir  |   | <input type="checkbox"/> |
|                          | CW                    | EP                        | 490,848             | B1                                | 06-17-1992                  | Andersson et al.                                |   | <input type="checkbox"/> |
|                          | CX                    | EP                        | 541,500             | A1                                | 06-12-1998                  | Andersson et al.                                |   | <input type="checkbox"/> |

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| Examiner Signature | Date Considered |
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| <b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br><br>(use as many sheets as necessary) |   | <b>Complete if Known</b> |                   |                        |                 |
|   |   | Application Number       | 10/718,779        |                        |                 |
|   |   | Filing Date              | November 20, 2003 |                        |                 |
|   |   | First Named Inventor     | CHISHTI, MUHAMMAD |                        |                 |
|   |   | Art Unit                 | 3732              |                        |                 |
|   |   | Examiner Name            | Wilson, John      |                        |                 |
| Sheet   | 3 | of                       | 10                | Attorney Docket Number | 018563-004820US |

| FOREIGN PATENT DOCUMENTS |                          |                           |                     |                                   |                                |   |  |                          |
|--------------------------|--------------------------|---------------------------|---------------------|-----------------------------------|--------------------------------|---|--|--------------------------|
| Examiner<br>Initials*    | Cite<br>No. <sup>1</sup> | Foreign Patent Document   |                     |                                   | Publication Date<br>MM-DD-YYYY | Name of Patentee or<br>Applicant of Cited<br>Document | Pages, Columns, Lines,<br>Where Relevant<br>Passages or Relevant<br>Figures Appear | T <sup>6</sup>           |
|                          |                          | Country Code <sup>3</sup> | Number <sup>4</sup> | Kind Code <sup>5</sup> (if known) |                                |   |  |                          |
|                          | CY                       | EP                        | 731,673             | B1                                | 09-18-1998                     | Andersson et al.                                      |  | <input type="checkbox"/> |
|                          | CZ                       | EP                        | 774,933             | B1                                | 05-28-1997                     | Oden et al.   |  | <input type="checkbox"/> |
|                          | DA                       | FR                        | 2,652,256           | A1                                | 03-29-1991                     | Jourda  |  | <input type="checkbox"/> |
|                          | DB                       | FR                        | 2,369,828           | A1                                | 06-02-1978                     | Suyehiro  |  | <input type="checkbox"/> |
|                          | DC                       | WO                        | 90/08,512           | A1                                | 08-09-1990                     | Lemcren   |  | <input type="checkbox"/> |
|                          | DD                       | WO                        | 91/04,713           | A1                                | 04-18-1991                     | Jourda et al.   |  | <input type="checkbox"/> |
|                          | DE                       | WO                        | 94/10,935           | A1                                | 05-26-1994                     | Andreiko et al.                                       |  | <input type="checkbox"/> |
|                          | DF                       | WO                        | 98/44,865           | A1                                | 10-15-1998                     | Andersson   |  | <input type="checkbox"/> |
|                          | DG                       | WO                        | 98/58,596           | A1                                | 12-30-1998                     | Chishti et al.  |  | <input type="checkbox"/> |

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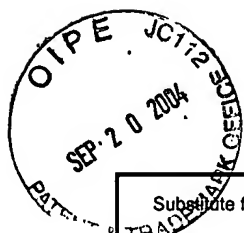
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|  |   | Art Unit                 | 3732              |                        |                 |
|  |   | Examiner Name            | Wilson, John      |                        |                 |
| Sheet  | 4 | of                       | 10                | Attorney Docket Number | 018563-004820US |

| NON PATENT LITERATURE DOCUMENTS |                          |  |                |
|---------------------------------|--------------------------|--|----------------|
| Examiner<br>Initials *          | Cite<br>No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.                                  | T <sup>2</sup> |
|                                 | DH                       | ALEXANDER et al., "The DigiGraph Work Station Part 2, Clinical Management," JCO (July 1990), pp. 402-407.  |                |
|                                 | DI                       | ALTSCHULER et al., "Laser Electro-Optic System for Rapid Three-Dimensional (3D) Topographic Mapping of Surfaces," <i>Optical Engineering</i> , Vol. 20(6) (1981), pp. 953-961.   |                |
|                                 | DJ                       | ALTSCHULER et al., "Measuring Surfaces Space-Coded by a Laser-Projected Dot Matrix," <i>SPIE Imaging Applications for Automated Industrial Inspection and Assembly</i> , vol. 182 (1979), p. 187-191.  |                |
|                                 | DK                       | ALTSCHULER et al., "Analysis of 3-D Data for Comparative 3-D Serial Growth Pattern Studies of Oral-Facial Structures," Program and Abstracts of Papers, Feb. 1975, <i>Journal of Dental Research</i> , Vol. 54, IADR Abstracts 1979, 2 pages total.  |                |
|                                 | DL                       | ALTSCHULER, "3D Mapping of Maxillo-Facial Prosthesis," AADR Abstract #607, 1980, 2 pages total..   |                |
|                                 | DM                       | American Association for Dental Research, Summary of Activities, March 20-23, 1980, Los Angeles, CA, p. 195.   |                |
|                                 | DN                       | ANDERSSON et al., "Clinical Results with Titanium Crowns Fabricated with Machine Duplication and Spark Erosion," <i>Acta Odontologica Scandinavica</i> , vol. 47 (1989), pp. 279-286.  |                |
|                                 | DO                       | BAUMRIND et al., "A stereophotogrammetric system for the detection of prosthesis loosening in total hip arthroplasty, Applications of Human Biostereometrics (NATO)," Proceedings of the Society of Photo-Optical Instrumentation Engineers, Vol. 166, July 9-13, 1978, pp. 112-123.             |                |
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|                                 | DQ                       | BAUMRIND et al., "Seminars in Orthodontics," <i>Seminars in Orthodontics</i> , Vol. 7, No. 4 (Dec. 2001), p. 222.  |                |
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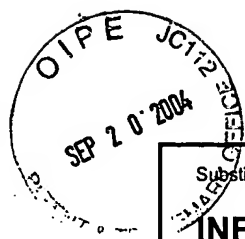
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|                                 | DX                       | BIGGERSTAFF, "Computerized Diagnostic Setups and Simulations," <i>The Angle Orthodontist</i> , Vol. 40, No. 1 (Jan. 1970), pp. 28-36.   |                |
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|                                 | EC                       | CHACONAS et al., "The DigiGraph Work Station, Part 1, Basic Concepts," <i>JCO</i> (June 1990), pp. 360-367.   |                |
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|                                 | EP                       | DenTrac Corporation, Dentrac document, pp. 4-13.  |                |
|                                 | EQ                       | DURET et al., "CAD-CAM in Dentistry," <i>Journal of the American Dental Association</i> , Vol. 117 (Nov. 1988), pp. 715-720.  |                |
|                                 | ER                       | DURET et al., "CAD/CAM imaging in dentistry," <i>Current Opinion in Dentistry</i> , Vol. 1 (1991), pp. 150-154.   |                |
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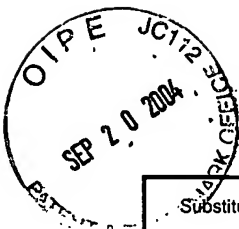
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| Substitute for form 1449B/PTO<br><br><b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br><br>(use as many sheets as necessary) |    | <b>Complete if Known</b> |                   |                        |                 |
|  |    | Application Number       | 10/718,779        |                        |                 |
|  |    | Filing Date              | November 20, 2003 |                        |                 |
|  |    | First Named Inventor     | CHISHTI, MUHAMMAD |                        |                 |
|  |    | Art Unit                 | 3732              |                        |                 |
|  |    | Examiner Name            | Wilson, John      |                        |                 |
| Sheet  | 10 | of                       | 10                | Attorney Docket Number | 018563-004820US |

| NON PATENT LITERATURE DOCUMENTS |                       |  |                |
|---------------------------------|-----------------------|--|----------------|
| Examiner Initials *             | Cite No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.    | T <sup>2</sup> |
|                                 | GZ                    | VAN DER ZEL, "Ceramic-fused-to-metal Restorations with a New CAD/CAM System," <i>Quintessence International</i> , vol. 24(11) (1993), pp. 769-778.   |                |
|                                 | HA                    | VÁRADY et al., "Reverse Engineering of Geometric Models - An Introduction," May 13, 1996, pp. 1-28.  |                |
|                                 | HB                    | WARUNEK et al., "Clinical use of silicone elastomer appliances" <i>JCO</i> , MH (10):694-700, 1989.  |                |
|                                 | HC                    | WARUNEK et al., "Physical and mechanical properties of elastomers in orthodontic positioners" <i>Am. J. Orthod. Dentofac. Orthop.</i> , 95:388-400, 1989.  |                |
|                                 | HD                    | WELLS, "Application of the positioner appliance in orthodontic treatment" <i>Am. J. Orthodont.</i> , 58:351-366, 1970.   |                |
|                                 | HE                    | WILLIAMS, "Dentistry and CAD/CAM: Another French Revolution," <i>Journal of Dental Practice Admin.</i> , Jan./March 1987, pp. 2-5.   |                |
|                                 | HF                    | WILLIAMS, "The Switzerland and Minnesota Developments in CAD/CAM," <i>Journal of Dental Practice Admin.</i> , pp. 50-55, April/June 1987.  |                |
|                                 | HG                    | WISHAN, "New Advances in Personal Computer Applications for Cephalometric Analysis, Growth Prediction, Surgical Treatment Planning and Imaging Processing," Symposium: Computerized Facial Imaging in Oral and Maxillofacial Surgery, AAOMS, Sept. 13, 1990, p. 5. |                |
|                                 | HH                    | YAMAMOTO et al., "Three-Dimensional Measurement of Dental Cast Profiles and Its Applications to Orthodontics," Annual Int'l Conf. of IEEE Engineering in Medicine and Biology Society, Vol. 12, No. 5, pp. 2051-2053, 1990   |                |
|                                 | HI                    | YAMAMOTO et al., "Optical measurement of dental cast profile and application to analysis of three-dimensional tooth movement in orthodontics," <i>Frontiers in Med. and Biol. Eng'g</i> , Vol. 1, No. 2 (1988), pp. 119-130.                                       |                |

|                    |  |                 |  |
|--------------------|--|-----------------|--|
| Examiner Signature |  | Date Considered |  |
|--------------------|--|-----------------|--|

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.